

## **REMARKS**

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of March 2, 2004.

All of the Examiner's objections and rejections are traversed.

Reexamination and reconsideration are requested.

### **State of the Claims**

Claims 1, 4 and 6-20 remain pending.

Claims 2, 3 and 5 have been previously cancelled.

Claims 4, 6-9, 15 and 17-20 have been allowed.

Claims 1, 13 and 14 stand rejected under 35 U.S.C. §112, second paragraph. However, claim 1 has been indicated as otherwise allowable provided the rejection under 35 U.S.C. §112 is overcome.

Claims 10-14 and 16 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ojha (US Patent No. 4,987,447) in view of Kurogane (US Patent No. 5,126,858).

### **Summary of the Claim Amendments**

As requested by the Examiner, claim 1 has been amended to further clarify what was meant by "at least one of the set of output media."

Claims 13 and 14 have been amended to address the alleged lack of antecedent basis. Claim 10 clearly recites "one or more individual sheets of output media," and claims 13 and 14 now clearly recite "the individual sheets of output media."

As the 35 U.S.C. §112 rejections have now been traversed, it is respectfully requested that the rejections be withdrawn.

### **The Present Claims Distinguish Patentably over the Applied Reference(s)**

Regarding claims 1, 4, 6-9, 15 and 17-20, the Examiner's recognition of the allowable nature of these claims is greatly appreciated. However, Applicant again notes, in particular, that one specific aspect of a claim does not result in patentable subject matter, but rather the claims when interpreted on the whole define patentable subject matter. Accordingly, Applicant believes the Examiner's statements regarding the reasons for finding patentable subject matter are not the

only reasons the claims distinguish patentably over the art. In short, while the Applicant agrees that the claims are allowable, the Applicant does not concede that they are only allowable for the precise reasons stated by the Examiner nor are the respective features identified absolutely necessary for patentability.

The rejection of claims 10-14 and 16 is hereby traversed. Notably, the Examiner appears to have misread and/or erroneously applied Kurogane. The Examiner alleges that FIG. 2 of Kurogane shows an output media that comprises a print area, indicating that the whole sheet is a print area. However, this is inaccurate. The control sheet **100** of FIG. 2 is not output media. Rather, it is input media that is read by the device to automatically configure processing of the job upon which the control sheet is stacked. See, e.g., FIG. 3 and column 5, line 21-30. Clearly, then it would not have been obvious to combine Kurogane with Ojha in a manner which reads on the claims. Moreover, the Examiner has already conceded that "Ojha does not teach the marker being placed on the same output media as the job content." Therefore, insomuch as Kurogane's control sheet is not even output media, it is irrelevant what may or may not be placed thereon. Combining Kurogane with Ojha does not makeup for what Ojha does not teach.

Additionally, claim 10 calls for "generating a marker representing at least one of the desired finishing instructions." Kurogane generates no such marker which is placed on output media as claimed. The Examiner seems to imply that the message "ABCD" printed on **230a** and/or **230b** as shown in FIG. 5 equates to the claimed marker. However, it is not reasonable to equate the them since the "ABCD" message does not represent a finishing instruction as claimed. Therefore, Kurogane fails to teach the generation and placing of the claimed marker in the manner claimed. As the Examiner expressly states, Ojha also does not teach the marker being placed on the same output media as the job content. Accordingly, combining Kurogane with Ojha does not remedy Ojha's shortcomings.

Therefore, it is submitted that claim 10 along with claims 11-14 and 16 define patentably over the applied references of record.

### CONCLUSION

For the reasons detailed above, it is submitted all claims remaining in the application are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

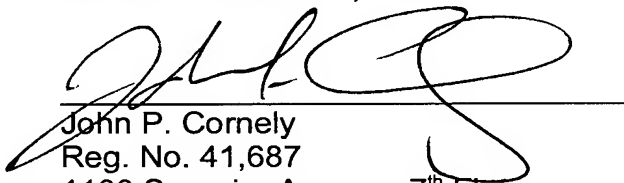
No additional fee is believed to be required for this Amendment After Final. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call John P. Cornely, at Telephone Number (216) 861-5582.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
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6/2/04  
Date

  
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